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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,745	09/28/2001	Alan Wightman	DEXNON/095/PC/US	8639
2543	7590	10-03/2003	EXAMINER	
ALIX YALE & RISTAS LLP 750 MAIN STREET SUITE 1400 HARTFORD, CT 06103			BOYD, JENNIFER A	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,745

Applicant(s)

WIGHTMAN ET AL.

Examiner

Jennifer A Boyd

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. The Applicant's Request for Reconsideration, filed July 9, 2003, has been entered and carefully considered. Claims 22 – 44 are pending. In view of Applicant's Arguments, the Examiner withdraws the rejection of claims 37 – 41 under 35 U.S.C. 102(b) as being anticipated by DuCharme (EP 712,889 A2), the rejection of claims 22 – 24, 28 – 29 and 31 – 36 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oxley et al. (US 5,942,354) and the rejection of claims 25 – 27 and 30 under 35 U.S.C. 103(a) as being unpatentable over Oxley et al. (US 5,942,354) as stated in paragraphs 4 – 5 and 7 - 9 of the previous Office Action dated April 10, 2003. The Examiner withdraws the rejection of claims 42 – 44 under 35 U.S.C. 102(a)(e) as being anticipated by Oxley et al. (US 5,942,354) as stated in paragraph 6 of the previous Office Action dated April 10, 2003. However, after an updated search, the invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 22 – 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. . The dependent claims 23 – 28, 30 – 33 and 35 - 36 are rejected as being dependent upon a rejected base claim.

Art Unit: 1771

Claims 22, 29 and 34 are indefinite because it is unclear what nonwoven webs would possess a lower cross direction wet expansion when compared to a similar web material comprising only the same cellulosic fibers because the Applicant has not set forth a comparative value in the claim. For sake of examination at this time, the Examiner will assume that any nonwoven web material containing cellulosic and synthetic fibers will inherently meet the lower cross direction wet expansion requirement. If the property is not inherent, then it is asserted that the claim is missing an element critical to the invention, which would patentably distinguish it from the prior art.

Claim Rejections - 35 USC § 102/103

4. Claims 22, 24 – 25 and 28 – 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rose (WO 95/10190).

Rose is directed to a porous bonded fibrous sheet material particularly suitable for conversion into food casings (Abstract).

As to claims 22 and 29, Rose teaches a porous substrate such as a paper comprising natural cellulosic fibers mixed with synthetic fibers (page 4, paragraph 3).

As to claim 24, Rose teaches that that paper is ideally prepared from long fibers such as abaca (page 4, paragraph 3).

As to claims 25 and 30, Rose teaches that cellulosic fibers are present in the porous substrate (page 4, paragraph 3). It should be noted that Rose does not specifically teach the use of wood pulp fibers as a cellulosic fiber in the substrate. However, the Applicant only requires

Art Unit: 1771

that the wood pulp component is present in the amount of **up to 50%**, therefore, the presence of 0% wood pulp which is implied by Rose would meet the Applicant's limitations.

As to claims 28 and 31, Rose teaches that the porous substrate is wet laid (page 4, paragraph 3).

As to claim 32, Rose teaches that the porous substrate is treated with a coating composition which is an admixture of polymer latex and a wet strength resin (page 4, paragraph 4).

As to claim 33, Rose teaches that the porous substrate is treated with viscose during the final conversion of the precursor material to form the food casing (page 4, paragraph 33). It should be noted that it has been held that the recitation that an element is "adapted" to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

As to claim 34, Rose teaches a porous substrate such as a paper comprising natural cellulosic fibers mixed with synthetic fibers (page 4, paragraph 3). Rose teaches that the porous substrate is treated with a coating composition which is an admixture of polymer latex and a wet strength resin (page 4, paragraph 4) and viscose during the final conversion of the precursor material to form the food casing (page 4, paragraph 33).

As to claim 35, Rose teaches that the porous substrate may be impregnated with the resin and viscose in one step (page 8, paragraph 2). Rose teaches that the substrate absorbs the viscose treatment during the final conversion of the precursor material to form the food casing (page 4, paragraph 33).

Art Unit: 1771

As to claim 36, Rose teaches that the porous substrate is dried using steam heated drying cylinders (page 7, paragraph 6).

As to claims 22, 29 and 34, although Rose does not explicitly teach the claimed lower cross direction wet expansion compared to a similar web material comprising only the same cellulosic fibers, it is reasonable to presume that the lower cross direction wet expansion value is inherent to Rose. Support for said presumption is found in the use of like materials (i.e. a porous substrate made of a paper comprising cellulosic and synthetic fibers) which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594. In addition, the presently claimed property of a lower cross direction wet expansion compared to a similar web material comprising only the same cellulosic fibers would obviously have been present once the Rose product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

5. Claims 26 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (WO 95/10190).

Rose discloses the claimed invention except for that the porous substrate includes synthetic fibers in the amount of 0.5 to 20% by weight as required by claim 26 and the content of synthetic fibers in the porous substrate is from 3 to 9% by weight of the total weight as required by claim 27. It should be noted that the amount of cellulosic and synthetic fibers in the substrate are result effective variables; for example, as the amount of cellulosic fibers increases, the substrate will become more paper-like. As the amount of synthetic fibers increases, the substrate

Art Unit: 1771

will become more heat stable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to Rose, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the level of cellulosic and synthetic fibers to create a substrate with properly balanced elasticity, thermal stability and strength.

6. Claims 23 and 37 – 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rose (WO 95/10190) in view of Ito et al. (US 5,705,214).

Rose is directed to a porous bonded fibrous sheet material particularly suitable for conversion into food casings (Abstract).

As to claims 37 and 42, Rose teaches a porous substrate such as a paper comprising natural cellulosic fibers mixed with synthetic fibers (page 4, paragraph 3). Rose teaches that the porous substrate is treated with a coating composition which is an admixture of polymer latex and a wet strength resin (page 4, paragraph 4) and viscose during the final conversion of the precursor material to form the food casing (page 4, paragraph 33).

As to claim 38, Rose teaches that that paper is ideally prepared from long fibers such as abaca (page 4, paragraph 3).

As to claim 39, Rose teaches that cellulosic fibers are present in the porous substrate (page 4, paragraph 3). It should be noted that Rose does not specifically teach the use of wood pulp fibers as a cellulosic fiber in the substrate. However, the Applicant only requires that the

Art Unit: 1771

wood pulp component is present in the amount of **up to 50%**, therefore, the presence of 0% wood pulp which is implied by Rose would meet the Applicant's limitations.

As to claim 43, Rose teaches that the porous substrate is wet laid (page 4, paragraph 3).

As to claim 44, Rose teaches that the porous substrate is dried using steam heated drying cylinders (page 7, paragraph 6).

As to claims 23, 37 and 42, Rose teaches the claimed invention above, however, fails to teach that the synthetic fibers in the porous substrate are selected from polyester, polyester copolymer, polyamide, polyamide copolymer, polyolefin and polyolefin copolymer or a mixture thereof.

Ito et al. is directed to casings fabricated from a food component transfer sheet (Abstract). Ito teaches a base sheet made from a paper or nonwoven fabric comprising natural fibers and synthetic fibers such as polyester, nylon or other plastic fibers (column 3, lines 14 – 24).

It would have been obvious and necessary for one of ordinary skill in the art practicing the invention of Rose to provide the details of the synthetic fiber. As polyester and nylon (polyamide) are commonly employed synthetic fibers which provide reinforcement and heat stability to a casing material, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use polyester or nylon as the synthetic fiber as suggested by Ito in the invention of Rose, motivated by the expectation of successfully practicing the invention of Rose.

Art Unit: 1771

As to claims 40 and 41, Rose in view of Ito discloses the claimed invention except for that the porous substrate includes synthetic fibers in the amount of 0.5 to 20% by weight as required by claim 40 and the content of synthetic fibers in the porous substrate is from 3 to 9% by weight of the total weight as required by claim 41. It should be noted that the amount of cellulosic and synthetic fibers in the substrate are result effective variables; for example, as the amount of cellulosic fibers increases, the substrate will become more paper-like. As the amount of synthetic fibers increases, the substrate will become more heat stable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to Rose in view of Ito, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In the present invention, one would have been motivated to optimize the level of cellulosic and synthetic fibers to create a substrate with properly balanced elasticity, thermal stability and strength.

Response to Arguments

7. Applicant's arguments with respect to claims 22 - 44 have been considered but are moot in view of the new ground(s) of rejection.

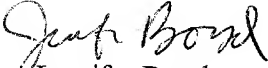
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

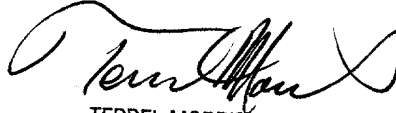
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the

Art Unit: 1771

organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Jennifer Boyd
September 30, 2003


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700